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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/554,373	05/11/2000	ROMAN DOSTALEK	48644	2258

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EXAMINER

SHIPPEN, MICHAEL L

ART UNIT PAPER NUMBER

1621

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/554,373

Applicant(s)

DOSTALEK ET AL.

Examiner

MICHAEL L. SHIPPEN

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Claim Rejections - 35 USC § 112<sup>1</sup>***

Claims 1-9 are rejected under 35 USC 112, second paragraph, as failing to particularly point out the claimed invention. The expression "where appropriate" is ambiguous since there is no indication of what would or would be considered "appropriate".

***Claim Rejections - 35 USC § 102<sup>2</sup>***

Claims 1-3 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 4,608,422. See the examples. The claim language "esters thereof" reads on the acyloxy polymer reactants of the prior art. As to the

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<sup>1</sup> The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 112 that form the basis for the rejections under this section made in this Office action:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

<sup>2</sup> The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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requirement of the presence of halogen of instant claim 5, the claim language reads on trace amounts that would be inherent in the prior art reactants. It is also noted that the reference indicates halogen containing reactants such as those made from vinyl halides may be used, note the last full paragraph of column 2.

Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 4,939,307. See the examples. As to the requirement of the presence of halogen of instant claim 5, the claim language reads on trace amounts that would be inherent in the prior art reactants.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by USP 5,969,194. See the examples. As to the requirement of the presence of halogen of instant claim 5, the claim language reads on trace amounts that would be inherent in the prior art reactants.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claims 1-3 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 08-169855<sup>3</sup>. See the examples. As to the requirement of the presence of halogen of instant claim 5, the claim language reads on trace amounts that would be inherent in the prior art reactants.

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<sup>3</sup> The translation attached thereto is computer generated and not completely accurate.

***Claim Rejections - 35 USC § 103<sup>4</sup>***

Claims 1-3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4,608,422. The reference is applied as above. In addition to the specific examples of the reference, the reference clearly suggests that various reaction parameters may be varied to obtain similar results. It would be readily apparent to one of ordinary skill in the art that these obvious variations would afford similar results. The claims read on these obvious variation in the prior art process.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4,939,307. The reference is applied as above. In addition to the specific examples of the reference, the reference clearly suggests that various reaction parameters may be varied to obtain similar results. It would be readily apparent to one of ordinary skill in the art that these obvious variations would afford similar results. The claims read on these obvious variation in the prior art process.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,969,194. The reference is applied as above. In addition to the specific examples of the reference, the reference clearly suggests that various

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<sup>4</sup> The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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reaction parameters may be varied to obtain similar results. It would be readily apparent to one of ordinary skill in the art that these obvious variations would afford similar results. The claims read on these obvious variation in the prior art process.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08-169855. The reference is applied as above. In addition to the specific examples of the reference, the reference clearly suggests that various reaction parameters may be varied to obtain similar results. It would be readily apparent to one of ordinary skill in the art that these obvious variations would afford similar results. The claims read on these obvious variation in the prior art process. Moreover, to the extent the claims read on reactants not exemplified in the reference, the claimed reactants are quite analogous to the reactants exemplified in the reference. The differences in the reactants are found only in substituents that are removed from the reaction site and do not affect the outcome of the reaction. The reactive functional groups involved are the same and undergo the same conversion. The claimed process affords the products one would expect from the teaching of the prior art. The use of a new starting material in an otherwise old process is considered obvious.

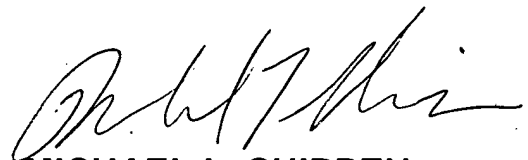
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***Conclusion***

The remaining references are cited as of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(571) 272-0647**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(571) 272-1600**. The official group FAX machine number is **571-273-8300**.

MShippen  
April 15, 2005



**MICHAEL L. SHIPPEN  
PRIMARY EXAMINER  
ART UNIT 1621**